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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/899,429

07/03/2001

Rudolf Hauptmann

98,385-J

7549

20306

7590

09/12/2002

MCDONNELL BOEHNEN HULBERT & BERGHOFF  
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CHICAGO, IL 60606

EXAMINER

O HARA, EILEEN B

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 09/12/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/899,429

Applicant(s)

HAUPTMANN ET AL.

Examiner

Eileen B. O'Hara

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-59 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 4 or 6, classified in class 424, subclass 185.1.
  - II. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 8, classified in class 424, subclass 185.1.
  - III. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 10, classified in class 424, subclass 185.1.
  - IV. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 12, classified in class 424, subclass 185.1.
  - V. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 14, classified in class 424, subclass 185.1.

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VI. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 16, classified in class 424, subclass 185.1.

VII. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 18, classified in class 424, subclass 185.1.

VIII. Claims 1-59, in so far as they are drawn to a method for ameliorating the harmful effects of TNF in an animal, comprising administering to an animal in need of such treatment a TNF binding polypeptide of SEQ ID NO: 20, classified in class 424, subclass 185.1.

The inventions are distinct, each from the other because of the following reasons:

Although these various proteins are all TNF binding proteins, each represents a patentably distinct product, with different sequences and structures and with distinct physical and functional characteristics. SEQ ID NOS: 4 and 6 were kept together because SEQ ID NO: 6 appears to be identical to SEQ ID NO: 4 except for an extra methionine at the N-terminal end. However, each of the other polypeptides comprise different sequences and have different lengths, and it is not clear how these polypeptides are related, and each would have to be searched separately, which would be a burden. Furthermore, each separate polypeptide as well as encoding nucleic acid molecule would

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have to be searched, so that eighteen different sequence searches would be required, which would be burdensome. Accordingly, restriction is proper.

Because these inventions are distinct for the reasons given above and the search required for one sequence is not required for any other sequence, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

**If Applicant could provide information, such as sequence alignments of all of the polypeptides, that demonstrates that the polypeptides are related and would not have to be searched separately, the restriction requirement would be withdrawn.**

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eileen B. O'Hara, whose telephone number is (703) 308-3312.

The examiner can normally be reached on Monday through Friday from 9:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler can be reached at (703) 308-6564.

Official papers Before Final filed by RightFax should be directed to (703) 872-9306.


Official papers After Final filed by RightFax should be directed to (703) 872-9307.

Official papers filed by fax should be directed to (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Eileen B. O'Hara, Ph.D.

Patent Examiner

  
YVONNE EYLER, PH.D.  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600